

**REMARKS**

This is in response to the Office Action of August 21, 2009. Claims 17-22 are cancelled, without prejudice to their reassertion in a divisional application. Claim 12 is amended to expressly recite the basis for the mass-% already recited in claim 12, based, *e.g.*, upon disclosure in lines 28-29 on page 19 and in lines 5-6 and 21 on page 20 of the specification. Claim 13 is amended to expressly recite the basis for the mass-% already recited in claim 12, based, *e.g.*, upon disclosure in lines 11-13 and 25 on page 21 of the specification. These amendments do not change the scope of claims 12 and 13. A typographical error is corrected in claim 25. Claims 24 is cancelled, without prejudice. No new matter is introduced by this Amendment. Claims 1, 3-5, 12, 13, 15, 16, 23, and 25-29 are now pending in the application.

Objection was raised to claim 25. Office Action, page 5. The amendment of claim 25 hereinabove overcomes the objection.

Claims 12, 13, and 25-29 were rejected under the second paragraph of 35 U.S.C. § 112. Office Action, page 6. The amendments of claims 12 and 13 hereinabove overcome the rejection under the second paragraph of 35 U.S.C. § 112.

Claims 1, 3-5, 15, 16, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/64401 to Natividad Jose et al. ("Jose"). Office Action, pages 6-9. The rejection is respectfully traversed.

The presently claimed cosmetic provides superior sensory feel and safety properties, particularly due to its combination of a tetraquastrimethylsiloxysilane of formula (1) – referred to hereinafter as "M4Q" – and a methyltrimethicone of formula (2) – referred to hereinafter as "M3T." These superior properties are demonstrated by the comparison between Example 11 and Comparative Example 22 in the specification. The superior properties provided by the present invention are also demonstrated by the comparison between Example 16 and Comparative Example 28 in the specification.

In more detail, the UV-ray protective cosmetic base of Example 11, in which M4Q and M3T were combined in a specified ratio, showed superior performance in all of the evaluation categories of “No irritation to the skin,” “Comfortable to apply,” “Suitable as a cosmetic base,” and “No straining after applied” as compared to the composition of Comparative Example 23, in which volatile cyclic silicone hexamer (D6) and M3T were combined in the same ratio as in Example 11. See the Table bridging pages 95 and 96 of the specification. Moreover, the sunscreen agent of Example 16, in which M4Q and M3T were combined in a specified ratio, exhibited superior performance in all four of these evaluation categories as compared to the sunscreen agent of Comparative Example 28, in which a volatile linear silicone tetramer and M3T were combined in the same ratio as in Example 16. See the Table bridging pages 95 and 96 of the specification.

Jose discloses the combination of at least two silicones selected from  $D_a$ ,  $MD_bD'_cD''_dM$ ,  $M_eT_f$ , and  $M_gQ_h$  (see, e.g., Jose claim 1). The combination of  $M_eT_f$  and  $M_gQ_h$  in Jose includes the combination of M4Q and M3T in Examples 11 and 16 of the present application. In addition, the combination of  $D_a$  and  $M_eT_f$  in Jose includes the combination of D6 and M3T in Comparative Example 22 of the present application. Furthermore, the combination of  $MD_bD'_cD''_dM$  and  $M_eT_f$  in Jose includes the combination of the volatile linear silicone tetramer and M3T in Comparative Example 28 of the present application. In the Jose disclosure, the combination of  $M_eT_f$  and  $M_gQ_h$ , the combination of  $D_a$  and  $M_eT_f$ , and the combination of  $MD_bD'_cD''_dM$  and  $M_eT_f$  are taught as being equivalent to one another.

In terms of the present invention, the Jose teaching is that M4Q and M3T in Examples 11 and 16 of Applicants' specification, the combination of D6 and M3T in Comparative Example 22 of Applicants' specification, and the combination of the volatile linear silicone tetramer and M3T in Comparative Example 28 of Applicants' specification are equivalent to one another. However, Applicants have *unexpectedly* discovered that the precise combination of particular organosilicon components required by Applicants' claim 1 are in fact *superior* to other combinations of organosilicon components that Jose teaches they should be equivalent to. Therefore, any *prima facie* case of obviousness raised by the Jose disclosure is rebutted by the evidence presented in Applicants' specification and discussed

above. Withdrawal of the rejection of claims 1, 3-5, 15, 16, and 23 as being unpatentable over Jose is in order and is earnestly solicited.

Claims 12, 13, and 26-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US 2004/0197284 A1 to Frederic Auguste ("Auguste"). Office Action, pages 9-11. The rejection is respectfully traversed.

The oil-based cosmetic of Applicants' claim 12, which requires among other things a polybutene component, exhibits superior effects in sensory properties. This unexpected superiority is demonstrated by the comparison between Examples 7 and Comparative Example 8 in Applicants' specification. Specifically, the lipstick of Example 7 – in which M4Q, a pigment, and polybutene were combined in a specified ratio – exhibited superior performance in all of the evaluation categories of "Long-lasting," "Gloss," "Bright color," "No dry feel," "Smoothness in application," and "Good spreadability" as compared to the results provide by the otherwise similar lipstick of Comparative Example 8, in which ceresin, a non-volatile oil, was substituted for polybutene. See the Table bridging pages 70 and 71 of the specification.

Auguste teaches various non-volatile oils as being equivalent to one another. Paragraph [0199]. Nothing in the Auguste disclosure would lead a person of ordinary skill in the art to expect superior sensory property results from the combination of polybutene with M4Q and a pigment in the ratios specified in Applicants' claims.

Additionally, the solid makeup cosmetic of Applicants' claim 13 exhibits superior effects on the skin and superior stability, based particularly on the combination of components (A) to (F) in a specified ratio. This is demonstrated by a comparison between Applicants' Example 9 and Comparative Examples 10 to 21. The solid foundation of Example 9 – representative of the present invention – exhibited superior performance in all of the evaluation categories "Excellent affinity for the skin," "Comfortable to apply," "Long-lasting]," "No dry feel when applied," and "Non-greasy." See the Table bridging pages 78 and 79 of the specification. It also exhibited superior stability. See the Table bridging pages 80 and 81 of the specification. In contrast, the solid foundation of Comparative Examples 10

to 21 – in which some of components (A) to (F) were absent or components (A) to (F) were combined in ratios different from those required by Applicants' claims – exhibited inferior performance in at least three of the above five evaluation categories regarding their effects on the skin. See the Table bridging pages 78 and 79 of the specification. They also exhibited inferior stability, except Comparative Examples 10 and 15. See the Table bridging pages 80 and 81 of the specification.

The Auguste disclosure teaches persons of ordinary skill in the art that cosmetics within the scope of claim 13 and cosmetic outside of the scope of claim 13 are equivalent to one another. Consequently, the markedly superior effects exhibited by the cosmetics within the scope of Applicants' claim 13 is unexpected from the Auguste disclosure.

Any *prima facie* case of obviousness raised by Auguste is rebutted by the evidence presented in Applicants' specification and discussed above. Withdrawal of the rejection of claims 12, 13, and 26-29 as being unpatentable over Auguste is in order and is earnestly solicited.

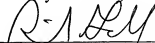
Claim 25, which depends from claim 12, was rejected under 35 U.S.C. § 103(a) as being unpatentable over Auguste in view of US 5,932,197 to Pascal Arnaud ("Arnaud"). Office Action, page 11. The rejection is respectfully traversed. The deficiencies of the primary reference with respect to claim 12 are discussed above. Arnaud likewise does not teach or suggest that a cosmetic in which polybutene is combined with M4Q and a pigment in a specified ratio would exhibit superior effects in its sensory properties. Withdrawal of the rejection of claim 25 as being unpatentable over Auguste in view of Arnaud is in order and is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher (Reg. No. 28,781 ) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: November 23, 2009

Respectfully submitted,

By  #28,781  
Gerald M. Murphy, Jr.  
Registration No.: 28,977  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Rd  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicant